

PEB Qualifying Examinations

Candidate Guidance – FD3 Amendment of Specifications

Introduction

This guidance has been prepared to assist candidates preparing for the PEB Qualifying Examinations. It is intended to identify the knowledge and experience candidates should attain prior to sitting the examination.

Different candidates will have widely different opportunities for training and gaining experience, depending on the pattern of work in their firms or companies. This guidance is designed to help candidates to identify areas where the knowledge and experience gained in the workplace will have to be supplemented through tutorials, seminars, training courses, private study or other means.

This guidance should be read together with the FD3 syllabus. Syllabi are reviewed annually and updated versions are published on the PEB website in the April before the October examination session. It is recommended that candidates familiarise themselves with the Acts and Rules set out in the syllabus.

Candidates are recommended to make use of past question papers and mark schemes, which are also available on the PEB website. In addition, the Principal Examiners' reports on the examinations explain common areas of weakness seen in candidates' answers.

Examiners report that there is a clear link between the length of professional experience and success in the Qualifying Examinations. It is unlikely that candidates with less than three years' experience in the profession, including at least a year acting mainly on their own responsibility, will have sufficient experience to be successful in the FD3 examination. Candidates who concentrate on the practical issues in the scenario tend to be more successful. For example, if a client needs the claims to cover a new product (their own or a third party product) on the market, but the relevant claims are worded too broadly for patentability, such as from the objections/prior art located by the Examiner, then the claim amendment(s) selected have both to be patentable (be clear; be novel; support a reasonable inventive step argument; not add subject matter, etc.) but **also** still cover the product. Candidates who move beyond merely identifying a difference, writing a response and just reporting the facts in isolation of what is important to the client, will gain more of the marks available in this paper than those who do not.

FD3 tests skills in prosecution techniques geared to a commercially relevant situation. Candidates need to allow adequate time to write a client report which indicates the steps taken; how the client's position is still protected; and the practical consequences of the position taken in response. For example, if the amended claims might lead to a lack of unity objection, the client has to be advised that divisional costs may need to be borne in the future if objection is raised and the client wishes to pursue all of the claims.

In addition to professional experience listed below, candidates are advised to attend at least twelve hours per year of CPD seminars, including some delivered outside their workplace, such as those offered by CIPA. Candidates are also advised to regularly read a monthly IP law publication.

Overview

The FD3 examination is a test of competence to respond to patentability objections by

argument and amendment while ensuring that the patent claims remaining in an application (or proposed for a divisional application) not only meet the requirements for patentability (including for example clarity) and amendment but are still of commercial value to the applicant.

While the precise materials may change from year to year, typically the question paper comprises at least: one patent text, one office action, prior art documents or relevant extracts and instructions from the client or other indicating the commercial interest in the invention covered by the patent text.

The FD examinations test candidates' ability to assess issues pertinent to the facts presented taking into account regulatory requirements (IPReg's Core Regulatory Framework), the Registered Patent Attorney's duties to clients, and professional ethics applicable to IP practitioners. A script that contains unethical advice, proposals or statements does not meet the requirements for award of a Pass in an FD examination.

Guidance

The FD3 examination tests candidates' competence in:

- (a) Amending Claim 1, if necessary, to fix any errors and to address any concerns in the examination report or client letter;
- (b) Correcting and expanding the dependent claim set, if possible and advisable, to provide additional and useful fallback positions;
- (c) Proposing an independent claim for a divisional application (if appropriate);
- (d) Producing a response to the UKIPO that includes a summary of the basis for any amendments, a novelty analysis, and an inventive step analysis, and that deals with any other items specifically raised in the paper (e.g. extensions of time); and
- (e) Providing a memo that forms the basis for a report to the client which **explains** the actions taken (not only describing what has been done), answers the client's questions, and (importantly) identifies any potential weaknesses in the response that the client should be aware of.

Candidates are expected to comment on the relevance of all documents to the patentability of the claims, whether this is in the response to the UKIPO or in the memo to the client. Either a Pozzoli/Windsurfing analysis or the EPO problem-solution approach to inventive step is acceptable, but it is important that the candidates do not confuse the two approaches in their argumentation.

It is strongly recommended that before taking the FD3 examination, candidates should have:

1. Developed an appropriate level of knowledge and experience by:
 - Responding to 30 official actions from the UK and/or European Patent Office
 - Reviewing, and responding to at least some of, ten written opinions from an IPEA
 - On at least one occasion, if the opportunity is available, considering and advising (the client or supervising attorney) on amendment in preparation for or during European opposition proceedings
 - Preparing and filing at least one divisional application.

2. Familiarised themselves with the significant case law on novelty, inventive step, clarity and amendment issues (including the filing of divisionals) as indicated in the relevant sections of or as reported in:
 - Case Law of the Boards of Appeal of the European Patent Office
 - CIPA Black Book
 - Reports of Patent, Design and Trade Marks Cases
 - Official Journal of the European Patent Office.
3. Developed an understanding of examination principles of novelty, inventive step, clarity and amendment (including the filing of divisionals) in the UK and European Patent Offices as indicated in:
 - The Patent Office Manual of Patent Practice
 - Guidelines for Examination in the European Patent Office

In particular candidates should be familiar with the tests used by the EPO and the UKIPO respectively when assessing inventive step and the exclusion of certain subject matter from patentability.

4. Developed competence in drafting practice as examined in FD2 Amendment of Specifications.